



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,708	10/23/2003	Nigel Vicker	15469.0003	9747
27890	7590	05/09/2006	EXAMINER	
STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			SHAMEEM, GOLAM M	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,708

Applicant(s)

VICKER ET AL.

Examiner

Golam M. M. Shameem, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 38-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37, 63 and 64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/15/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

This application claims benefit for foreign priority under 35 U.S.C. § 119(a)-(d) to United Kingdom 0224830.0 10/24/2002, however the certified copy of priority document has not been received or made part of the file. Therefore, any priority claim to this document has not been perfected.

Status of Claims

Claims 1-64 are currently pending in the application.

Receipt is acknowledged of amendment / response filed on March 17, 2006 and that has been entered.

Claims 38-62 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142 (b) as being drawn to a non-elected subject matter.

Information Disclosure Statement

Receipt is acknowledged of Information Disclosure Statement (IDS), filed on 06/15/2004, which has been entered in the file.

Response to Election/Restriction

In response to the restriction requirement, Applicants have elected Group I, which includes claims 1-37, 63 and 64, drawn to compounds and the elected species as set forth (appearing on page 73 of the specification, Response page 1), is acknowledged. Because Applicants did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without** traverse (MPEP § 818.03(a)). Nevertheless, Examiner may reconsider to rejoin method of use claims commensurate in scope

with the product claims when the case would be found in condition for allowance [provided those process / method claims are free from 35 U.S.C. §112 first (including written description, reach-through claim language and/or scope-enablement issues) and second paragraphs]. Therefore, the requirement for restriction in is still deemed proper.

Applicants preserve their right to file a divisional on the non-elected subject matter.

Claim Rejections - 35 USC § 102

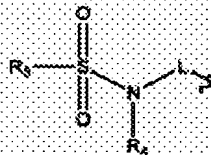
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-37, 63 and 64 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yoshino *et al* (1995). Applicant claims compounds capable of inhibiting hydroxysteriod dehydrogenase enzyme, and their methods of uses thereof. Yoshino *et al* also disclose the synthesis of several heterocyclic sulfonamide derivatives and at least one of them anticipates the

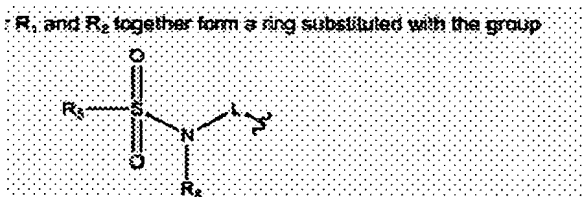
R₁ and R₂ together form a ring substituted with the group



instantly claimed invention of formula I, wherein

R³ is a substituent (such as O), X is C (R₇)(R₈) [wherein (R₇)(R₈) are both H], L is a linker group, R⁴ is H, R₅ is hydrocarbyl group (such as aryl ring), [STN International, HCAPLUS database, RN 165668-28-0, a copy is provided with this Office action], which reads on the instantly claimed compound.

Claims 1-37, 63 and 64 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kitazawa *et al* (1998). Kitazawa *et al* disclose the synthesis of several heterocyclic sulfonamide derivatives and at least one of them anticipates the instantly claimed invention of formula I,



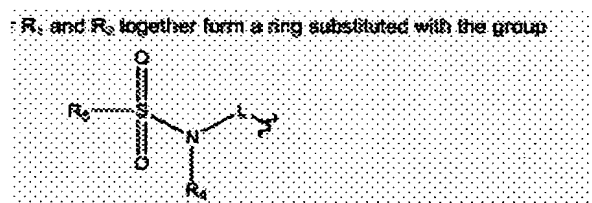
wherein R^3 is H, X is C(R_7)(R_8) [wherein (R_7)(R_8) are both H], L is a linker group, R^4 is H, R^5 is hydrocarbyl group (such as aryl ring), [STN International, HCAPLUS database, RN 214615-14-2, a copy is provided with this Office action], which reads on the instantly claimed compound.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-37, 63 and 64 are rejected under 35 U.S.C. § 102(a) as being anticipated by Arrhenius *et al* (2002). Arrhenius *et al* disclose the synthesis of several benzothiazole derivatives and at least one of them anticipates the instantly claimed invention of formula I, wherein



, R^3 is a substituent (such as S), X is S, L is a linker group, R^4 is hydrocarbyl, R^5 is hydrocarbyl group (such as aryl ring), [STN International,

HCAPLUS database, RN 452104-11-9, a copy is provided with this Office action], which reads on the instantly claimed compound.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Tuesday-Thursday from 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (571)-273-8300.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy

Art Unit: 1626

published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

Golam M M Shameem, Ph.D.
Primary Examiner
Art Unit 1626
Technology Center 1600



GOLAM M. M. SHAMEEM, PH.D
PRIMARY EXAMINER

May 06, 2006